

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Applicant asserts that the relevant terms and limitations have proper references to the specification and drawings in the Summary of Claimed Subject Matter section of the Appeal Brief filed on February 17, 2008. Applicant does admit that not every single word in the claims has a corresponding reference to the specification or drawings. However, the purpose of this section of the Appeal Brief is to aid the Board in determining the scope of the invention by giving the Board quick cites into the specification and drawings where the limitations are described and shown. Applicant believes that to provide references for every single word would make the Summary too long and counter-productive.

During the telephone interview on July 14, 2008, the Examiner asserted that the ONLY proper way to draft a Summary of Claimed Subject Matter is to copy the independent claims and insert references to the specification and drawings therein.

Applicant disagrees with the Examiner's assertion. Rule 37 C.F.R. § 41.37(c)(1)(v) does NOT require that the Applicant copy the claim verbatim into the Summary of Claimed Subject Matter section of the Appeal Brief. Indeed, the Patent Office's interpretation of this rule does not require verbatim copying of a claim. See MPEP § 1205.02(v). Yet, anything less than that will be determined to be non-compliant by the Examiner.

In addition, the Examiner's proposal gives the Board redundant information. That is, a proper Appeal Brief requires a claims appendix. Therefore, copying the claim verbatim into the Summary of Claimed Subject Matter is basically redundant to what is in the claims appendix. Rather than give the Board redundant information, Applicant chose

to write a summary that would assist the Board in interpreting the claims which it needs to do anyway in determining if the rejections are proper or not.

Instead of dealing with the merits of the rejections, the Examiner is apparently attempting to have Applicant write the Summary of Claimed Subject Matter exactly as he wants it be. The tool the Examiner is using to accomplish this goal is the Notice of Non-Compliant Appeal Brief. This is improper for several reasons.

First, the Patent Office does not require that the Examiner be 100% satisfied with Applicant's Summary of Claimed Subject Matter. If it did, it would not have MPEP § 1207.02 (A) (5) that requires the Examiner to provide a statement that he/she "agrees or disagrees with the summary of claimed subject matter contained in the brief and an explanation of any disagreement," in the Examiner's Answer. Clearly if Applicant has to go through a plurality of Notices of Non-Compliant Appeal Brief, eventually there might be agreement and thus no need for the MPEP to provision for any disagreement. Or if the Notices get so numerous, Applicant may be forced to abandon the application out of economic defeat in paying for all the corresponding Replies. In short, the Examiner's interpretation of 37 § C.F.R. 41.37(c)(1)(v) cannot be used to force an Applicant to write the Summary of Claimed Subject Matter as the Examiner wants it. The proper place to address any alleged deficiencies is in the Examiner's Answer where disagreements may be lodged.

Second, the Examiner is asking Applicant to be a mind reader. In the Notice of Non-Compliant Appeal Brief, the Examiner asserts the terms "coupled," "extract using voice recognition," and "converted" were not properly given references to the specification or the drawings. Applicant would like to point out that "converted" is not

used in claim 1 and therefore does not need to be referenced in the specification or drawings¹.

In addition to those specific words, the Examiner also uses “etc.” to infer that additional terms and limitations are not properly referenced. However, the Examiner fails to spell them out. Thus, Applicant must now chose between finding references for EVERY SINGLE word in the claim or guessing which words the Examiner covers with “etc.” and being wrong so that another Notice of Non-Compliant Appeal Brief is issued. As stated earlier, referencing every single word in a claim will not assist the Board in reaching its decision. Thus, Applicant is forced to guess which terms need referencing by the Examiner.

In an effort to put this issue to rest, Applicant is submitting herewith a Supplemental Appeal Brief that includes additional paragraphs in the Summary of Claimed Subject Matter that includes a verbatim copy of claim 1 with references to the specification and drawings as required by the Examiner. However, Applicant maintains this is unnecessary and the Summary of Claimed Subject Matter in the Appeal Brief filed on February 17, 2008 is proper.

¹ Applicant would also like to point out that the exact phrase “extract using voice recognition” is not used in the claim. However, the phrase “extracting anomaly information from said recorded portions using voice recognition,” is used in the claim.

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Respectfully submitted,

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